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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,958	01/25/2001	Hans Heid	(Z) 98017 P US	7016

7590 12/17/2002

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EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/770,958

Applicant(s)  
Heid

Examiner  
Clark F. Dexter

Art Unit  
3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 26, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above, claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of Group I (claims 1-7) in the response filed November 26, 2002 (paper no. 5) is acknowledged. The traversal is on the ground(s) that "both Group I and Group II comprise common claims, 1 and 7. Thus, both groups are linked by the features of these claims." This is not found persuasive because claims 1 and 7 have not been determined to both have the same special technical feature or features (i.e., the feature or features that patentably distinguishes the claimed invention over the prior art). However, if it is determined that claims 1 and 7 have the same special technical features, rejoinder of groups I and II will be considered.

2. Claims 8-10 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper and is therefore made FINAL.

### ***Priority***

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on May 29, 1998. It is noted, however, that applicant has not filed a certified copy of the German application as required by 35 U.S.C. 119(b).


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***Information Disclosure Statement***

4. The information disclosure statement filed January 25, 2001 (paper no. 2) has been received and the references listed thereon have been considered.

***Drawings***

5. The drawings are objected to because of the following informalities:

In Figure 1, it seems that a numeral (e.g., 100) should be added to indicate the knife holder for clarity. 

In Figure 5, numeral 16 indicates two different features which is improper, and it seems that the lower occurrence of numeral 16 should be changed.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Abstract***

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as

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“means” and “said,” should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, “The disclosure concerns,” “The disclosure defined by this invention,” “The disclosure describes,” etc.

7. The abstract of the disclosure is objected to because it is too long. ✓ Appropriate correction is required. See MPEP § 608.01(b).

### *Specification*

8. The disclosure is objected to because of the following informalities:

On page 7, line 15, it seems that a numeral (e.g., 100) should be inserted after “knife holder” or the like for clarity. ←

On page 8, line 13, it seems that a numeral such as numeral (8) should be inserted after “blade guard” or the like. ←

On page 10, line 9, a numeral should be inserted after “base member” for clarity; in line 18, a numeral such as numeral (17) should be inserted after “electromagnet” or the like. ←

On page 12, lines 5-6, and in line 8, each occurrence of the recitation “base portion (34) of the knife holder” appears to be inaccurate, and it seems that each occurrence should read -- base portion of the knife holder (34)-- or the like. ←

Appropriate correction is required.

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***Claim Rejections - 35 USC § 112***

9. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 4, the recitation "remote from a specimen" renders the claim vague and indefinite since the invention is being positively defined in terms of the workpiece which is not part of the claimed invention; in lines 4-5, the recitation "spaced apart from said cutting plane" is vague and indefinite since the location of the cutting plane has not been positively defined in terms of the claimed features of the invention.

In claim 4, line 2, the recitation "pivotably or displaceably" is vague and indefinite as to which one, particularly since they are not equivalents.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 4, 6 and 7, as understood, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fassin, pn 1,925,181.

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***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fassin, pn 1,925,181.

Regarding claim 3, Fassin lacks the plate comprising a transparent material. However, the Examiner takes Official notice that it is old and well known in the art to make guard plates transparent for various known benefits including reducing obstructed views during use of a device or for aesthetic benefits. Therefore, it would have been obvious to one having ordinary skill in the art to make the guard of Fassin transparent for the well known benefits including those described above.

Regarding claim 5, Fassin lacks a switch and the plate coupled thereto. However, the Examiner takes Official notice that it is old and well known in the art to provide switches for various reasons including lock switches to lock a member in place and/or to release a member. Therefore, it would have been obvious to one having ordinary skill in the art to provide a switch coupled to the plate of Fassin for the well known benefits including those described above.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404. The examiner's typical work schedule is Monday, Tuesday, Thursday and Friday, and he can be reached during normal business hours on these days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Allan Shoap, can be reached at (703)308-1082.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3590; informal/draft papers - (703)305-9835.



**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

cfd  
December 16, 2002